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TO: Assistant Commissioner for Patents
Attention: Steven Meyers
Patent Technology Center 3600

FROM: Eugene S. Stephens

DATE: March 27, 2001

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APPLICANT(S): William P. Newton, Robert M. Lucci, and
Thomas F. Batten

APPLN. NO: 08/839,161

FILED: 22 April 1997

EXAMINER: C. Cohen

GROUP ART UNIT: 3634

TITLE: SUPPORT SYSTEM FOR LATERALLY REMOVABLE SASH

A Request to Reconsider the Decision Denying Petition Regarding
Holding of Non-compliance of Appeal Brief under 37 CFR 1.192 and a
Redraft of Brief Section 7 - Grouping of Claims are transmitted
herewith.

#26

- 1 -

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT(S): William P. Newton, Robert M. Lucci, and Thomas F. Batten	
APPLN. NO: 08/839,161	EXAMINER: C. Cohen
FILED: 22 April 1997	ART UNIT: 3634
TITLE: SUPPORT SYSTEM FOR Laterally Removable Sash	

**REQUEST TO RECONSIDER THE DECISION DENYING PETITION
REGARDING HOLDING OF NON-COMPLIANCE OF APPEAL BRIEF
UNDER 37 CFR 1.192**

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Appellants request reconsideration of the above Petition Denial mailed 14 March 2001 (received in the office of appellants' attorney on 21 March 2001) for the reasons explained below. These reasons emerged upon review of the circumstances after a phone conference with Steven Meyers (with the office of the Director of Patent Technology Center 3600) in which appellants' attorney finally learned how the Patent Office views the requirements of 37 CFR 1.192(c)(7).

The Brief compliance requirement asserted by the Examiner is incorrect for being incomplete and misleading. The Brief argued separate patentability for many, but not all, of the claims in rejected groups; and the Examiner incorrectly asserted that this is impermissible. The Examiner's requirement left appellants only the possibilities of (a) letting all claims stand or fall as grouped or (b) providing a separate argument for every claim. There was no hint from the Examiner's statement of the compliance requirements that less than all the claims could be separately argued, providing that a statement on claim grouping specified which claims are separately argued.

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- 2 -

If appellants' attorney could have learned from the Examiner that the way the Brief argues for separate patentability of less than all the claims is permissible, providing that the claim grouping statement specifically lists the claims separately argued, then the Petition would not have been made. Such a solution would have been readily adopted as a simple and reasonable request, compared to the argue-every-claim demand incorrectly made by the Examiner.

Appellants enclose a proposed redraft of Section 7 of the Appeal Brief adding specifics to the claim grouping statement to show exactly which claims are supported by separate reasons for patentability and therefor do not stand or fall with the groups of claims as rejected. This proposed redraft of the claim grouping statement is believed to bring the Brief into compliance with the rule, without adopting the argue-every-claim assertion imposed on appellants by the Examiner's holdings of non-compliance.

The Petition process, which has been an unfortunate way of learning the Patent Office view of rule 192, has succeeded in overcoming the requirement incorrectly imposed by the Examiner. In that sense, the Petition can be granted--with a requirement that appellants file a substitute Brief having the corrected claim grouping statement as proposed herewith. Granting the Petition in such a way would not say that the unamended Brief complied but that the argue-every-claim requirement was wrong.

Equities also favor reconsidering and conditionally granting the Petition. A promptly filed substitute Brief amended according to the enclosed proposal will satisfy the requirements of the Board of Appeals much better than inserting additional argument for every claim as the Examiner would have required. The Petition could have been avoided by better communication from the Examiner or by more complete detail in the rule or the MPEP. Appellants, who have not caused the problem, should not be burdened with application abandonment, revival, and late fees. This is especially unjust when appellants' Petition has led to a compliance solution avoiding the argue-every-claim requirement imposed by the Examiner.

- 3 -

For all these reasons, appellants respectfully request that the Petition be reconsidered and granted, providing that a substitute Brief is promptly filed with the submitted claim grouping statement.

Respectfully submitted,
EUGENE STEPHENS & ASSOCIATES



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Enclosure

Dated: 27 March 2001

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I hereby certify that this correspondence is being transmitted by facsimile to the Patent and Trademark Office on 27 March 2001.



Carol Austin

Redraft of Brief Section 7 - Grouping of Claims**7. Grouping of Claims**

The claims in the different groups of claims as rejected do not stand or fall as a group. Separate reasons for patentability are offered for claims 1, 2, 4, 7, 12, 13, 16, 19, 22, 24, 29, 30, 31, 32, 35, 37, 39, 40, 41, 42, 43, 44, 45, 46, 47, 49, 51, 52, 53, 59, 61, 64, 67, 68, 69, 70, 73, 74, 75, 76, 78, 79, 80, 81, 85, and 86, which do not stand or fall with the groups of claims as rejected.